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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/967,302	09/28/2001	Steven J. Gatewood	IP 6141 US	5206

25230 7590 03/25/2003

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EXAMINER

TARAZANO, DONALD LAWRENCE

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 03/25/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/967,302

Applicant(s)

GATEWOOD ET AL.

Examiner

D. Lawrence Tarazano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 13 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4, 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of claims 1-23 in Paper No. 8 is acknowledged. The traversal is on the ground(s) that the laminate of claim 1 is the same as the laminate used in the process of claim 24, and that the searches are coextensive. This is not found persuasive because the structure of claim 1 need not be used for the process set forth in claim 24.

2. The MPEP clearly states that a restriction bases on this premise is proper. "The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product" (MPEP § 806.05(h)). The applicants have provided no reasons why the laminate may not be used for a non-package forming application. The flat sheet could be used for signage.

3. Second the searches are divergent. A search for the laminate as claimed would not require a search in the package making art

4. The requirement is still deemed proper and is therefore made FINAL.

Claim Objections

5. Claims 3, 4, 12, 13, 16, 19, and 20 are objected to because of the following informalities:

6. The term "metallocene low density polyethylene" is grammatically improper. The word "catalyzed" should be inserted following "metallocene". The word metallocene is a noun and is improperly used as an adjective by the applicants.

7. Claim 16 has two periods after the number 16.

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8. Appropriate correction is required.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

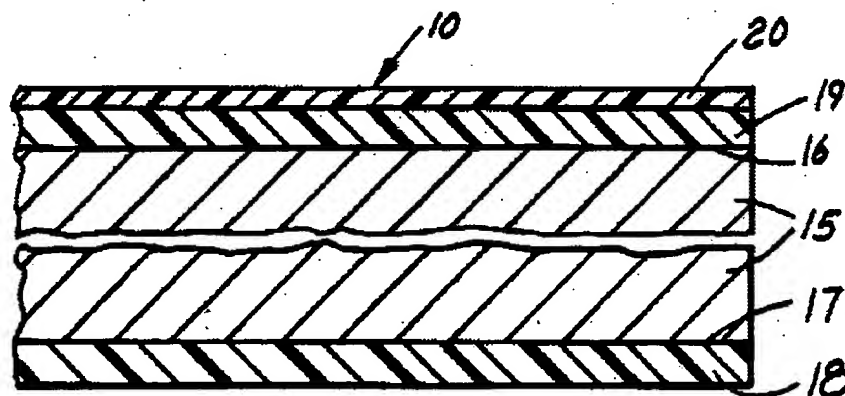
(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

10. Claims 1, 2, 4, 5, 6, 7, 8, 10, 11, 13-18, 20-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Martin, Jr. 4,806,398.

As shown by figure 3 below, Martin teaches a multilayer structure comprising a biaxially oriented polyester layer (20), a LDPE adhesive layer (19), and a paperboard substrate (15). See column 6, lines 44+.

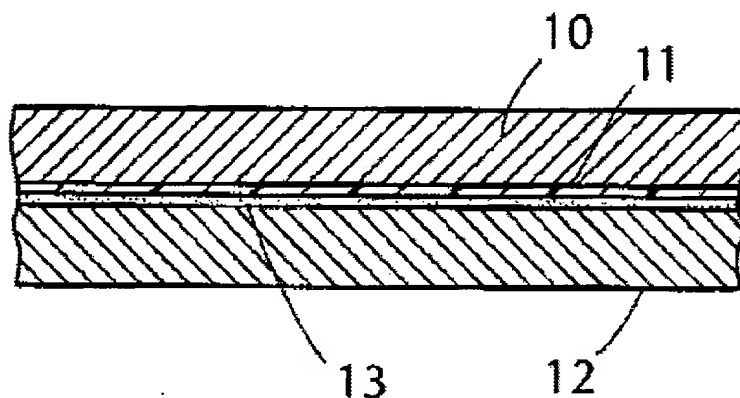


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The structures may be surface treated by methods such as flame or corona treatment (column 9, lines 25+) and the structures may be printed. See claims 1 and 4 and the examples.

11. Claims 1, 2, 3, 6, 7, 10, 11, 12, 15-19, 21, 22 and 23 rejected under 35 U.S.C. 102(b) as being anticipated by Finestone et al. (5,565,252).

Finestone teaches a laminate comprising a biaxially oriented film layer (12), an adhesive layer (11) and a paper support layer (10).

FIG. 1

The film layer can be polypropylene, polyester or polyethylene (column 2, lines 56+).

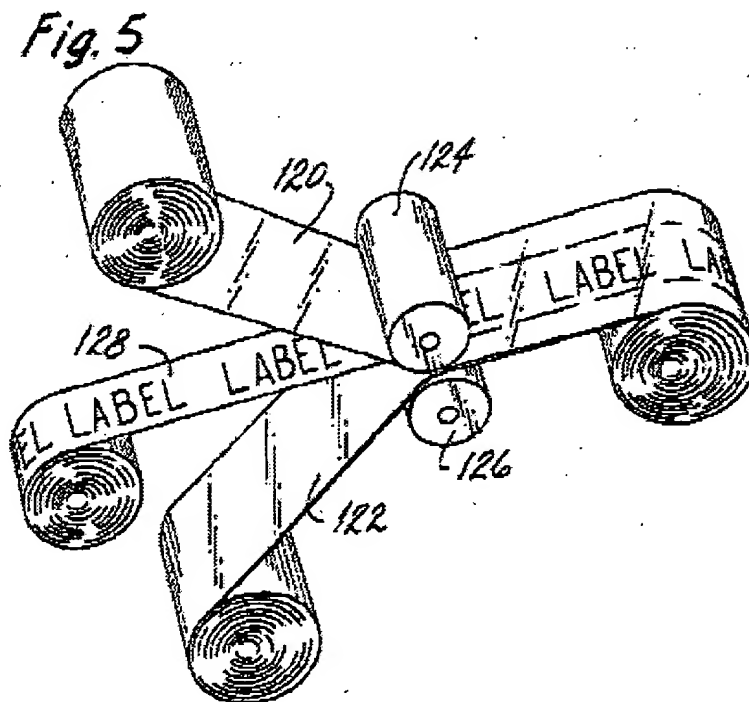
Regarding claim 3 etc. that require specific forms of polyethylene, the examiner takes the position that the all the different forms of polyethylene if taken in total equate to the generic disclosure of polyethylene in Finestone. The applicants essentially cover all forms of polyethylene in their claims.

The paper layer may be printed (column 4, lines 17+) and the film corona treated to make it receptive (column 4, lines 60+).

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12. Claims 1, 4-10, 13-17, 20, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Wiggins et al. (3,924,0512)

13. Wiggins et al teach biaxially oriented films comprising a layer of vinylidene chloride and a layer of an ethylene unsaturated ester (ethylene vinyl acetate). These films are laminated to one or both sides of a paper layer (Example V and Example VII). Figure 6 shows two layers of the film being laminated to a printed substrate.



Since the printing is sandwiched between the biaxially oriented plastic film (120) and the paper layer (128), the ink layer would be sandwiched between the two structures. The examiner takes the position that the end product would be the same as one in which the film was printed.

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Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 5, 6, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiggins et al. (3,924,0512) or Martin, Jr. 4,806,398.

16. Each Wiggins et al. and Martin, Jr. are printed films, which are used in the packaging arts. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have printed the surface layer of the plastic or the paper or both depending on how the packaging was used. For example packaging graphic might be printed on the surface of paper, but things such as dates, prices, batch numbers etc... might be printed on the surface of the film at the time it is formed into a package to indicate something particular about the materials which were packaged. This would be nothing more than standard packaging operations.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Lawrence Tarazano whose telephone number is (703)-308-2379. The examiner can normally be reached on 8:30 to 6:00 (off every other Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J Thibodeau can be reached on (703)-309-2367. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703)-872-9310 for regular communications and (703)-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-0661.

D. Lawrence Tarazano
Primary Examiner
Art Unit 1773



dlt
March 19, 2003